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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,785

Applicant(s)

Clark et al

Examiner

Andrew J. Fischer

Art Unit

3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 3, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 28, 2000 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3627

DETAILED ACTION

Restriction

1. Applicants' election of Group I (claims 1-7 and 13-15) in Paper No. 3 is acknowledged.

Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 8-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 3.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claims:

- a. The "identify a supplier by use of said search" as recited in claim 1.
- b. The "purchasing said product" as recited in claim 1.
- c. The "searching said information templates" as recited in claim 13.
- d. The "fixing attributes of a product" as recited in claim 13.

Art Unit: 3627

4. The Examiner notes the claims are replete with the above drawing errors. All method steps recited in the claims are clearly not shown in the drawings. The Examiner highly recommends Applicant review all 10 claims to ensure that every method step recited is shown in the drawings. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office Action to avoid abandonment of the application. The objections to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112 2nd Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 1, it is unclear if “a supplier” as recited in line 10 is a subset of the “plurality of suppliers” as recited in line 5. If this is the case, the Examiner suggests inserting after “supplier” in line 10 --from the plurality of suppliers--. “[S]emantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]” *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (citations and quotations omitted).

Art Unit: 3627

b. In claim 15, it is unclear if the “identifying at least one supplier of said several interconnected components” is a single supplier for all components or one supplier for each component. The Examiner interprets the claim to mean at least one supplier for each of the several components.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-5 and 13-15, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et. al. (U.S. 6,023,683) (“Johnson ‘683”). Johnson ‘683 discloses the claimed method including identifying a plurality of suppliers (the set of suppliers in the “different suppliers”, column 4, ~line 47); creating an information template for each supplier (the template fields passed via data interface 60 comprising all or a subset of the twelve fields, column 5, ~line 65 through column 6, line 3); specifying the product or component (inherent); searching (via 50) each of the information templates for the specified product (searching for the desired product by e.g. part number and creating hit list 47); purchasing the product from the

Art Unit: 3627

identified supplier (ordering items from the order list after inventory sourcing); placing certain information on the information template related to the cost of producing the product (the product “list price”); causing a design file of the product to be created (a catalog image); evaluating the design file before purchasing (the user can scroll through the hit list 47 and view an image, column 10, lines ~65 through column 11, lines ~2); creating information relating to the operation of the product (the product number) and placing it within the template; a file server 200; a local personal computer 220; fixing attributes of the product (list price); and the time required to provide a product or component (the availability).

9. It is the Examiner’s principle position that since Johnson ‘683 discloses searching by product number, and the product could be a subset of a larger assembly, Johnson ‘683 inherently discloses searching with templates by both product and component such as in auto parts. In fact, noting in Johnson ‘683 prevents the parts disclosed from being auto parts. Furthermore, while one product number could refer to a product, the next product number could just as easily (and most likely does) refer to a component within an assembly or larger product. Therefore the “decomposing said product into several interconnected components” is inherent since the part number would already reflect this decomposition.

10. Functional recitations using the word “for” (e.g. “for purchasing a product” as recited in claim 1) have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246

Art Unit: 3627

F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

11. After careful review of the specification and prosecution history, the Examiner is unaware of any desire—either expressly or implicitly—by Applicants to be their own lexicographer and define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning. See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001) (“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”); *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366, 62 USPQ2d 1658, 1662 (Fed. Cir. 2002) (There is a “heavy presumption that a claim term carries its ordinary and customary meaning.”). See also MPEP §2111.01 and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).¹

¹ It is the Examiner’s position that “plain meaning” and “ordinary and accustom meaning” are synonymous. See e.g. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) (“[A]ll terms in a patent claim are to be given their plain, ordinary and accustomed meaning . . .”).

Art Unit: 3627

a. In accordance with the ordinary and accustom meaning presumption, the claims are interpreted during examination with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).²

b. However, if Applicants desire any claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicants in their next response to expressly³ indicate the claim limitation at issue⁴ and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic

² See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

³ “Absent an *express intent* to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. [Emphasis added.]” *Wenger Manufacturing Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1232, 57 USPQ2d 1679, 1684 (Fed. Cir. 2001) (citations and quotations omitted).

⁴ “In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent’s scope must, at the very least, point to a term or terms in the claim with which to draw in those statements.” *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

Art Unit: 3627

evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term”).⁵ The Examiner cautions that no new matter is allowed.

c. Failure by Applicants in their next response to address this issue or to be non-response to this issue entirely will be considered a desire by Applicants to continue having the claims interpreted with their ordinary and accustomed meaning and with their broadest reasonable interpretation. Additionally, it is the Examiner’s position that above requirements are reasonable.⁶

⁵ See also *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996), (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, *as long as* the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

⁶ The requirements are reasonable on at least two independent grounds: first, the Examiner’s requirements are merely an express request for clarification of how Applicants intend their claims to be interpreted. Second, the requirements are reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both

Art Unit: 3627

d. Applicants are also cautioned that even though claim interpretation begins with this presumption, the prosecution history may further limit claim scope (e.g. in an interparty infringement suit) if Applicants disclaim or disavow a particular interpretation of the claims during prosecution. *Abbott Laboratories v. TorPharm Inc.*, 300 F.3d 1367, 1372, 63 USPQ2d 1929, 1931 (Fed. Cir. 2002).

12. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, June 3, 2002 available at www.uspto.gov/web/offices/com/strat2001/index.htm.

Art Unit: 3627

14. Claims 6 and 7, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson '683 in view of Danneels et. al. (U.S. 6,272,472 B1) ("Danneels"). Johnson '683 discloses as discussed above but does not directly disclose the global computer network as the Internet. Danneels teaches the concept of using the Internet as a buyer/seller communications medium.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson '683 as taught by Danneels to include using the Internet to do the product searching. More and more platforms are moving from proprietary networks to Internet based systems because most companies already maintain Internet based connections. By replacing their older systems with Internet based systems, the overall costs of the system is decreased and the system is easier to maintain.

15. Claims 5 and 13-15, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson '683.⁷ It is the Examiner's principle position that the decomposing products into several interconnected components is inherent in Johnson '683 as previously discussed. For example, if the products in Johnson '683 were auto parts, all would be interconnected (when assembled in e.g. a vehicle).

However if not inherent, the Examiner takes Official Notice that auto parts with part numbers are supplied from third party vendors (e.g. TRW, Mopar) and selectively assembled in

⁷ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

Art Unit: 3627

vehicles. It therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Johnson '683 to make the parts and part numbers various auto parts and assembled in a vehicle. Such a modification would have been an implementation of system found Johnson '683 and would have provided an easier way of searching for large volumes or product information regarding auto parts.

16. It is the Examiner's position that all claimed features in claims 1-7 and 13-15 are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Cram et. al. (U.S. 5,963,953); Yamada (U.S. 5,796,614); Johnson et. al. (U.S. 5,712,989); Willis et. al. (U.S. 5,515,269); Kyle et. al. (U.S. 5,285,392); Blaha et. al. (U.S. 5,119,307); Mukherjee (U.S. 5,197,001); and Dye (U.S. 4,459,663).

18. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

Art Unit: 3627

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

AJFischer 11/18/02
ANDREW J. FISCHER
PATENT EXAMINER

AJF
November 18, 2002